

### Remarks/Arguments

Pending in the application as amended in response to the Office Action identified as Paper No. 7 and dated 08 April 2003 are claims 1-4.

The Office Action reinstates a rejection of claims 1-4 under 35 U.S.C. § 103; specifically, the claims are said to be unpatentable as being obvious over a U.S. Patent to Peterson ("Peterson") in view of a U.S. Patent to Hunck et al. ("Hunck").

Previously, Applicants had taken two positions in arguing against the propriety of rejecting the claims based on the noted combination. First, Applicants had suggested that a *prima facie* case of obviousness had not been presented because of a lack of a proper suggestion to combine the teachings of the references. Second, Applicants remarked that the combination of Peterson in view of Hunck appeared to have been constructed through the use of impermissible hindsight.

The present Office Action (which has been made "FINAL") states that the combination is justified on the observation that "... Peterson and Hunck are functionally equivalent in the control valve art ...". Also, it is said the combination (whereby the manually controlled valve structure of Peterson is modified by use of the electrical or solenoid structure of Hunck) is appropriate "... as a matter of engineering expediency."

However, as is evident from the text of the Office Action, these statements are merely conclusory. Statements such as the above appear to be rooted solely in *a mere ability to combine* prior art without any statement (or reference thereto) that it is *the art* that suggests the desirability of making that combination; therefore, it is suggested that combination is inappropriate because of this reason. In re Mills, 916 F.2d 680, 682-83 (Fed. Cir. 1990); MPEP § 2143.01, Eighth Ed., revised February, 2003, West Group.

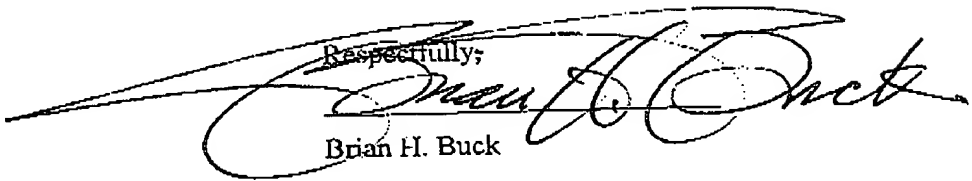
In fact, it appears that the Office Action, with its statements as noted above, uses the perspective of one of ordinary skill in the art as the motivation for the combination -- an inappropriate basis for a determination of obviousness. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999). This is seen in the statement that the obviousness of the combination would be suggested to one of ordinary skill in the art "... as a matter of engineering expediency."

Conclusion

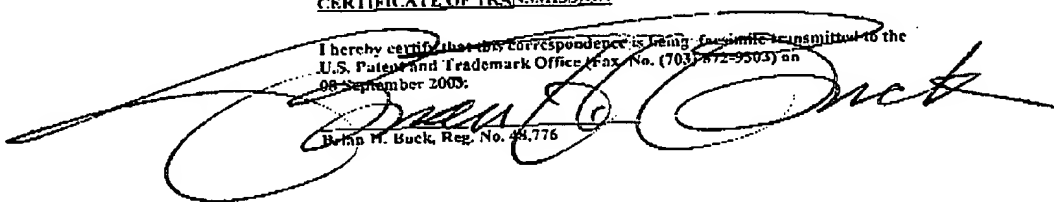
Without more, it is believed that this application continues to be in condition for allowance; accordingly, such allowance is respectfully requested.

Any fees or charges due as a result of filing of the present paper may be charged against Deposit Account 04-0525.

Respectfully;

  
Brian H. Buck

CERTIFICATE OF TRANSMISSION

  
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (fax No. (703) 672-9503) on 08 September 2003.

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